REMARKS

Claims 1-46 are all the claims pending in the application. By this Amendment, Applicant

amends claims 1, 30, 39, 41 and 43 to further clarify the invention and to correct minor errors.

The amendments to claims 1, 30, 39 and 41 were made for reasons of precision of language and

consistency, and do not narrow the literal scope of the claims and thus do not implicate an

estoppel in the application of the doctrine of equivalents.

Summary of the Office Action

Applicant thanks the Examiner for withdrawing the objections to the Title, the

Specification and the claims.

Applicant also thanks the Examiner for withdrawing the objections to the Drawings and

for indicating that Drawings are accepted. The Examiner indicated that the Drawings filed on

March 30, 2001 are accepted, Applicant believes the Examiner meant that the Drawings filed on

July 18, 2002 are accepted. If Applicant's belief is mistaken, the Examiner is respectfully

requested to indicate this in the next office action communication.

The Examiner found Applicant's arguments unpersuasive and maintained all of the

previous rejections. In particular, claims 1-40 and 46 stand rejected under 35 U.S.C. § 103(a)

and claims 41-45 stand rejected under 35 U.S.C. § 102(b). Applicant respectfully traverses these

rejections in view of the following remarks.

To begin, Applicant respectfully incorporates by reference all arguments submitted in the

Amendment under 37 C.F.R. § 1.111 filed on January 27, 2004.

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Claims 1-29

In particular, the Examiner rejected claims 1-6, 21 and 28-29 under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent No. 5,550,920 to Kupiec (hereinafter "Kupiec") in view of

U.S. Patent No. 4,579,533 to Anderson et al (hereinafter "Anderson"), claims 7-9 as being

unpatentable over Kupiec in view of Anderson and further in view of U.S. Patent No. 6,138,100

A to Dutton et al. (hereinafter "Dutton"), claims 10-12, 14 and 19-20 as being unpatentable over

Kupiec in view of Anderson and further in view of U.S. Patent No. 5,638,425 A to Meador III et

al. (hereinafter "Meador"), claim 13 as being unpatentable over Kupiec in view of Anderson et

al. and further in view of Meador and U.S. Patent No. 6,240,448 to Imielinski et al. (hereinafter

"Imielinski"), claims 15-16 as being unpatentable over Kupiec in view of Anderson and further

in view of U.S. Patent No. 6,581,055 to Ziauddin et al. (hereinafter "Ziauddin"), claim 17 as

being unpatentable over Kupiec in view of Anderson, Ziauddin et al. and further in view of U.S.

Patent No. 5,625,748 to McDonough et al. (hereinafter "McDonough"), claim 18 as being

unpatentable over Kupiec in view of Anderson, Meador and Ziauddin, claims 22 and 24 as being

unpatentable over Kupiec in view of Anderson, Meador and further in view of U.S. Patent No.

4,612,416 to Emerson et al. (hereinafter "Emerson"), claim 23 as being unpatentable over

Kupiec in view of Anderson, Meador and Dutton, and claims 25-27 as being unpatentable over

Kupiec in view of Anderson and further in view of Applicant's allegedly admitted prior art

(hereinafter "APA"). Applicant respectfully requests the Examiner to *carefully reconsider* and

withdraw this rejection.

To sum up this lengthy list of rejections, the Examiner alleges that independent claim 1 is

unpatentable over Kupiec in view of Anderson and that dependent claims 2-29 are unpatentable

by various combinations of these *two primary references* and *another seven references*. Since

claim 1 is the only independent claim, the other rejected claims being dependent, this response

focuses initially on claim 1. Claim 1, as now amended, among a number of unique features not

taught by the prior art references cited by the Examiner, recites:

> an automatic question unit operable to
> determine whether a user is connected via a
> voice-based or a text-based communication
> link, and for eliciting input from a user in
> accordance with said determination...
>
> a query formulation unit...for prompting said
> automatic question unit to elicit additional
> input from the user...

The Examiner maintained the rejection of claim 1 as being unpatentable over Kupiec in view of

Anderson.

In response to Applicant's arguments submitted in the Amendment under 37 C.F.R. §

1.111 filed on January 27, 2004, the Examiner alleges that original claim 1 does not include

certain features argued by the Applicant (page 4 of the Office Action). In addition, the Examiner

alleges that to modify Kupiec to ask for additional instructions as opposed to just repeating the

original question is obvious because repeating the original question would have the same

problematic result (page 5 of the Office Action). Finally, the Examiner alleges that there is

motivation to combine the two references because they are directed at solving the same problem

(page 3 of the Office Action). In addition, the Examiner alleges that Anderson would

incorporate the teachings of Kupiec to conserve ROM (see page 5 of the Office Action).

Applicant addresses the Examiner's arguments herein below.

First, the Examiner alleges that the original claim 1 did not include the feature of

determining whether a user is connected via a voice-based or a text-based communication link

(see page 4 of the Office Action). Applicant respectfully disagrees with the Examiner.

However, for the sake of expediting prosecution, Applicant amends claim 1 to clearly recite this

feature. In addition, Applicant respectfully submits that Kupiec does not teach or suggest

determining whether user input is via a voice-based or a text-based communication link. Kupiec

only has one transducer 220, which can only handle one type of input (see arguments in the

Amendment under 37 C.F.R. § 1.111, filed on January 27, 2004). Anderson fails to cure the

deficient teachings of Kupiec.

In Anderson, user input is always in a form of text via keypad. Anderson fails to teach or

suggest a voice-based communication link for user input. As such there is no determination of

whether the user is connected via a voice-based or a text-based communication link (see

arguments in the Amendment under 37 C.F.R. § 1.111, filed on January 27, 2004). In short, both

references fail to teach or suggest at least the automatic question unit, as set forth in claim 1.

Next, the Examiner alleges that to modify Kupiec to ask for additional instructions as

opposed to just repeating the original question is obvious because repeating the original question

would have the same problematic result (page 5 of the Office Action). The Examiner does not

cite any references for this proposition. Applicant respectfully submits that to modify Kupiec to

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ask for additional input from a user as opposed to repeating the same question is not obvious.

Kupiec suggests repeating the question because part of the utterance could be garbled (col. 11,

lines 1 to 5).

As a result, repeating the original question would not necessarily result in the same

problematic result. In fact, if the original answer is garbled in transmission, then it may be more

effective to repeat the original question as opposed to ask for additional input. In short,

Applicant respectfully submits that one of ordinary skill in the art would not find it obvious to

modify Kupiec's repeating the original question when user's utterance is garbled, to soliciting

addition input.

Finally, the Examiner alleges that there is motivation to combine the two references

because they are directed at solving the same problem (page 3 of the Office Action). In addition,

the Examiner alleges that Anderson would incorporate the teachings of Kupiec to conserve ROM

(see page 5 of the Office Action). To begin, Applicant respectfully point out that the two are not

related to solving the same problem. The nature of the problem addressed in Kupiec is

disambiguating words contained in an error-prone transcription (col. 1, lines 56 to 67), whereas

the nature of the problem addressed in Anderson is providing definitions of a text word and

reducing the costs of the required hardware and software (col. 1, lines 45 to 48). Clearly, the two

references deal with unrelated problems.

Moreover, if the Examiner alleges that there is motivation to incorporate Kupiec into

Anderson's teachings to keep the ROM requirements down (page 5 of the Office Action), then

Applicant respectfully request the Examiner to explain how Kupiec keeps the ROM requirements

down. Kupiec does not teach or suggest anything about the ROM requirements, especially about

reducing ROM requirements. As such, there is no suggestion to incorporate Kupiec into

Anderson (also see arguments presented in the Amendment under 37 C.F.R. § 1.111, filed on

January 27, 2004).

Based on at least the foregoing exemplary reasons, Applicant respectfully submits that

the combination of Kupiec and Anderson fails to teach or suggest all of the claimed elements as

arranged in claim 1. Therefore, the combination of Kupiec and Anderson clearly cannot render

the present invention as recited in claim 1 obvious. Thus, Applicant respectfully submits that

claim 1 is allowable, and respectfully requests that the Examiner withdraw the § 103(a) rejection

of claim 1. In addition, claims 2-6, 21 and 28-29 are patentable at least by virtue of their

dependency on claim 1.

The other dependent claims 7-20 and 22-27 are allegedly unpatentable in view of various

combinations of these *two primary references* and *another seven references*. Applicant

respectfully submits that these seven references, (Dutton, Meador, Imielinski, Ziauddin,

McDonough, Emerson and APA) taken alone or in any conceivable combinations fail to cure the

deficient teachings of Kupiec and Anderson.

For example, Dutton is relied upon only for its teaching of mobile phones (see pages 10-

11 of the Office Action). Dutton only teaches allowing the user to enter information using a

telephone keypad or by a voice entry (col. 7, lines 10 to 22); the reference fails to teach or

suggest attempting <u>to determine how the user is connected</u> to this Voice Activated Connection

system (e.g., to respond to user using the same connection mode). Dutton only teaches accepting

user input in either form; <u>no determination</u> is being made. Moreover, once user inputs initial

information, the VAC system begins searching all available resources; it fails to further query the

user based on what type of input was made or based on the type of the connection link with the

user. That is, Dutton teaches accepting voice based or text based input, but <u>no determinations</u>

<u>are made</u>. Clearly, Dutton does not compensate for the above-identified deficiencies of Kupiec

and Anderson.

Meador is relied upon only for its teaching of asking the user to spell out unrecognized

voice input, having a contact directory and Boolean searching (see pages 11-12 of the Office

Action). Meador only teaches allowing the user to spell out unrecognized user input first by

speaking the letters but if this fails, then the user may key in the letters (col. 4, lines 20 to 40).

Meador does not teach or suggest attempting <u>to determine how the user is connected</u> to this

mechanized directory assistance system. In other words, Meador does not teach or suggest

determining whether the user is connected via a voice-based or text-based communication link.

In fact, no determinations about the connection link is being made and the user always attempts

to communicate the initial request by speaking. Clearly, Meador does not compensate for the

above-identified deficiencies of Kupiec and Anderson.

With respect to Imielinski, it too fails to cure the deficient teachings of Kupiec and

Anderson. For example, Imielinski is relied upon only for its teaching of hierarchy of contact

point types (see page 12 of the Office Action). In general, Imielinski is directed to allowing the

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user to access world wide web via audio pages. In Imielinski, the user inputs a request via keypad of a telephone or via speaking a command (e.g. column number and then row number of the requested data on the page), see col. 3, lines 5 to 45. Imielinski does not teach or suggest attempting to determine how the user is connected to this mechanized directory assistance system. In fact, no determinations about the communication links are made.

Similarly, Zauddin does not cure the deficient teachings of Kupiec and Anderson. Ziauddin is relied upon only for its teaching of a question unit having a number of questions (see page 13 of the Office Action). In general, Ziauddin only deals with optimizing database queries and has nothing to do with audio systems. Ziauddin does not teach or suggest attempting to determine how the user is connected to a database interface. Clearly, Ziauddin does not compensate for the above-identified deficiencies of Kupiec and Anderson.

Likewise, McDonough is relied upon only for its teaching of interface operable to connect to the human operator (see page 15 of the Office Action). Clearly McDonough does not compensate for the above-identified deficiencies of Kupiec and Anderson. Just like, McDonough, Emerson is relied upon only for its teaching of inserting identification of the caller in the header of the message (see page 18 of the Office Action) and APA is relied upon for its teaching of a retrievable, super-imposable location, and these references do not compensate for the above-identified deficiencies of Kupiec and Anderson.

Moreover, in the Amendment under 37 C.F.R. § 1.111 (filed January 27, 2004), Applicant presented arguments as to why one of ordinary skill in the art would not have been

motivated to combine references in a manner suggested for Examiner. In particular, Applicant

respectfully submits that there is no motivation to combine Kupiec, Anderson, Meador and

Imielinski, nor to combine Kupiec, Anderson and Ziauddin, nor to Kupiec, Anderson, Meador

and Emerson, nor to combine Kupiec, Anderson and APA.

With respect to all these arguments, the Examiner responded by alleging that the fact that

Applicant has recognized another advantage cannot be basis for patentability when the difference

would otherwise be obvious (see page 5 of the Office Action). However, with respect to the

argument that there is no motivation to combine Kupiec, Anderson and Ziauddin, relevance of

the Examiner's remarks is not understood.

Applicant argued that one of ordinary skill in the art would never have consulted

Ziauddin when dealing with a problem of Anderson's audio dictionary or Kupiec's transcribing

speech or handwriting into a computer readable signal. Ziauddin not only addresses a different

problem but is also from a different field of endeavor. Therefore, there is no motivation to

combine Kupiec, Anderson and Ziauddin in the manner suggested by the Examiner. In short,

Applicant did not identify another advantage but explained how Ziauddin is inapplicable and

uncombinable with Kupiec and Anderson.

Next, with respect to arguments submitted that there is no motivation to combine Kupiec,

Anderson, Meador with Emerson. The relevance of the Examiner's remark mentioned above is

also not understood. Moreover, the Examiner alleged that messages are addressed in Emerson

(see page 6 of the Office Action), whereas in the Amendment under 37 C.F.R. § 1.111, Applicant

referred to Kupiec, Anderson and Meador and that these three references fail to address any

messaging.

In particular, with respect to these four references, the Examiner alleged that one of

ordinary skill in the art would have been motivated to combine the references so as to identify

the message before opening it for processing (pages 18-19 of the Office Action). In response,

Applicant argued that the primary reference cited by Examiner, Kupiec, deals with filtering

speech input and presenting user with documents discovered based on that input. Anderson

deals with providing voice dictionary for words shown on a page. Meador teaches a directory

assistance system, where the user is provided with the requested phone number. None of the

three references teaches or suggests having any messages at all. Therefore, there is no need for

a header which identifies the message.

In other words, one of ordinary skill in the art would not have been motivated to

incorporate Emerson's teachings of a header for messaging (so as to identify the message before

opening it for process) to systems of Kupiec, Anderson and Meador, which lack any messaging

capabilities, as alleged by the Examiner. In addition, Emerson is in a different field of endeavor

from the other references.

Applicant respectfully notes that *most if not all inventions arise from a combination of

old elements*. In re Kotzab, 55 USPQ2d at 1316 (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47

USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be

found in the prior art. *Id.* However, identification in the prior art of each individual part claimed

is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish

obviousness based on a combination of the elements disclosed in the prior art, there must be

some motivation, suggestion or teaching of the desirability of making the specific combination

that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d

1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221

USPQ 1125, 1127 (Fed. Cir. 1984)).

In the present case, as explained above, there is no motivation to combine the references

in a manner suggest by the Examiner. Therefore, one of ordinary skill in the art confronted with

a problem of the Kupiec, Anderson or Meador would not have turned to a reference like

Emerson, which deals with messaging services. In short, Applicant respectfully submits that

these four references are simply not combinable in a manner indicated by the Examiner.

In sum, Applicant respectfully submits that the teachings of these **nine** references taken

alone or in any conceivable combination would not have (and could not have) led the artisan of

ordinary skill to have achieved the subject matter of claim 1. Since claims 7-20 and 22-27 are

dependent upon claim 1, they may be patentable at least by virtue of their dependency.

Claims 30-38

Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador in

view of APA and claims 34-38 as being unpatentable over Meador, APA and further in view of

Anderson. Applicant respectfully requests the Examiner to *carefully reconsider* and withdraw

this rejection. Since claim 30 is the only independent claim, the other rejected claims being

dependent, this response focuses initially on claim 30.

Claim 30, among a number of unique features not taught by the prior art references cited

by the Examiner, original and as now amended, recites:

```
a receiver operable to receive said location
data from said location database in response
to a query involving said personal
identification data;
```

The Examiner maintained the rejection of claim 30 as being unpatentable over Meador in view

of APA. The Examiner did not respond to Applicant's arguments that Meador and APA fail to

teach or suggest a receiver, as set forth in claim 1, and did not further explain the reasons for

maintaining the rejection. The Examiner alleges that Meador's voice processing unit (VPU) 114

requesting the street number is equivalent to a receiver, as set forth in claim 30 and that

Applicant's APA teaches a location system and a positioner, as set forth in claim 30 (see pages

22-23 of the Office Action). Applicant respectfully disagrees with the Examiner.

Meador's VPU requests the street location if the directory database pulls up more than

one telephone number (Fig. 6; col. 8, lines 50 to 63). In particular, Meador uses the street

locations for differentiating between different names. In other words, Meador teaches just the

opposite. Meador teaches using the location to obtain personal information such as a phone

number. Meador fails to teach or suggest providing personal identification data (e.g. name,

phone number) to obtain an associated location. That is, in Meador, the user is queried for a

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street location to provide the desired telephone number as opposed to being queried for personal

information <u>to obtain a location for that person</u>.

The APA, on the other hand, only teaches a conventional GPS system and clearly fails to

cure the deficient teachings of Meador. It too fails to teach or suggest using personal data to

obtain associated location for determining a route. That is, the APA does not teach or suggest a

receiver, which receives a location from a database based on a query involving personal

identification data. In short, both Meador and APA, taken alone or in any conceivable

combination fail to teach or suggest a receiver, as set forth in claim 30.

In addition, in response to Applicant's argument that the Examiner is exercising

impermissible hindsight, the Examiner responded with a general statement that any judgement is

hindsight but as long as only knowledge known to an artisan of ordinary skill in the art at the

time of the invention is taken into account, the reconstruction is proper (see page 6 of the Office

Action). However, based on references cited by the Examiner, one of ordinary skill in the art

would only know Meador's <u>phone number directory</u> (which can use street location) and APA's

conventional GPS (determining based route when provided with the source and destination

addresses).

Applicant respectfully submits that based on that knowledge, it is unclear, why and how

one of ordinary skill in the art would combine a GPS and a phone number directory unless one of

ordinary skill in the art was trying to meet the claim language of the present invention. Based on

at least the foregoing exemplary reasons, Applicant respectfully submits that the combined

teachings of Meador and APA fail to teach or suggest all of the claimed elements as arranged in claim 30. Therefore, the combination of Meador and APA clearly cannot render the present invention as recited in claim 30 obvious. Thus, Applicant respectfully submits that claim 30 is allowable, and respectfully requests that the Examiner to withdraw the § 103(a) rejection of claim 30 and its dependent claims 31-33.

Next, the Examiner alleges that claims 34-38, which dependent on claim 30, are obvious in view of Meador, APA and Anderson. Applicant has already demonstrated that Meador and the APA do not meet all the requirements of independent claim 30. Anderson is relied upon only for its teaching of providing output in audio or text data. It clearly fails to compensate for the above-identified deficient teachings of Meador and the APA.

Moreover, there is no motivation for combining these references. Meador relates to a directory assistance, APA teaches a GPS and Anderson teaches reducing costs by keeping the ROM requirements low. No ROM is disclosed in Meador or the APA. The three references address completely different problems and do not provide motivation, suggestion or even an inkling for combining with each other. In short, one of ordinary skill in the art would not have combined Anderson to keep the ROM requirements low, as alleged by the Examiner.

Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 30. Since claims 34-38 are dependent upon claim 30, they may be patentable at least by virtue of their dependency.

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Claims 39 and 40

The Examiner rejected independent claim 39 under 35 U.S.C. § 103(a) as being

unpatentable over Anderson in view of Kupiec. Claim 39 recites a similar limitation to the

recitation of an automatic question unit operable to determine whether a user is connected via at

least one of a voice-based and a text-based communication link recited in claim 1, as well as

eliciting additional input from the user, as set forth in claim 1. Since claim 39 contains features

that are similar to the features argued above with respect to claim 1, those arguments are

respectfully submitted to apply with equal force here. For at least substantially the same

exemplary reasons, therefore, Applicant respectfully requests the Examiner to withdraw this

rejection of independent claim 39.

Furthermore, the Examiner rejected claim 40, which depends on claim 39, under 35

U.S.C. § 103(a) as being unpatentable over Anderson in view of Kupiec and further in view of

U.S. Patent No. 5,265,014 to Haddock et al. (hereinafter "Haddock"). Applicant has already

demonstrated that Kupiec and Anderson do not meet all the requirements of independent claim 1.

Haddock only teaches a multi-modal user interface (accepts referential, i.e., mouse click, and

textual input) for removing a referential ambiguity from a natural language and it does not

compensate for the above-identified deficiencies of Kupiec and Anderson. Together, the

combined teachings of these references would not have (and could not have) led the artisan of

ordinary skill to have achieved the subject matter of claim 39. Since claim 40 depends upon

claim 39, it may be patentable at least by virtue of its dependency.

<u>Claims 41-46</u>

Claims 41-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Kupiec and

claim 46 under 35 U.S.C. § 103(a) , as being unpatentable over Kupiec in view of Meador.

Applicant respectfully traverses this rejection in view of the following remarks. Since claim 41

is the only independent claim, the other rejected claims being dependent, this response focuses

initially on claim 41. Independent claim 41, as now amended, among a number of unique

features not taught by the prior art references cited by the Examiner, recites:

```
        wherein when said query items are
        insufficient to form said query for
        interrogating said database, receiving
        additional instructions in said
        communication mode for entering additional
        query items.
```

The Examiner maintained the rejection alleging that the features upon which Applicant relies are

not recited in the rejected claim and that in view of Kupiec (which repeats the question if user

input is garbled up), it would have been obvious to ask for further input because repeating the

original request would have the same problematic result (pages 4-5 of the Office Action).

To begin, to be an "anticipation" rejection under 35 U.S.C. § 102, the reference must

teach <u>every element and recitation of the Applicant's claims</u>. Rejections under 35 U.S.C. § 102

are proper only when the claimed subject matter is identically disclosed or described in the prior

art. Thus, the reference must clearly and unequivocally disclose every element and recitation of

the claimed invention.

Applicant respectfully submits that claim 41, as now amended, clearly recites features

relied on in the Applicant's arguments in the Amendment under 37 C.F.R. § 1.111, filed on

January 27, 2004. Moreover, Applicant respectfully points out that Kupeic operates based on the

assumption that user input is reasonable. Kupiec uses a co-occurrence approach. That is, Kupeic

only teaches receiving one original reasonable user request and transcribing it to various

interpretations to form a number of hypotheses. Kupiec only re-asks the question, if user input is

garbled up and the reference fails to query the user with additional instructions for additional

query items.

Therefore, *wherein when said query items are insufficient to form said query for*

interrogating said database, receiving additional instructions in said communication mode for

entering additional query items, as set forth in claim 41 is not suggested or taught by Kupeic,

which lacks receiving addition instruction for entering additional query items to form a

query. For at least these exemplary reasons, Applicant respectfully submits that independent

claim 41 is patentably distinguishable from Kupeic. Applicant, therefore, respectfully requests

the Examiner to reconsider and withdraw this rejection of independent claim 41. Also, Applicant

respectfully submits that claims 42-45 are allowable at least by virtue of their dependency on

claim 41.

Claim 46 is rejected under 35 U.S.C. § 103(a) , as being unpatentable over Kupiec in

view of Meador. Applicant respectfully traverses this rejection with respect to the dependent

upon claim 41, claim 46. Applicant has already demonstrated that Kupiec does not meet all the

requirements of independent claim 41. Meador is cited only for teaching interrogating a

database using a name. As such, Meador clearly fails to cure the deficient teachings of Kupiec.

Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 46,

which depends upon claim 41.

Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any
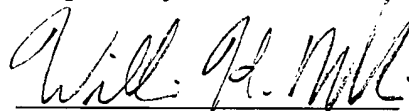
overpayments to said Deposit Account.

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